

## REMARKS

Claims 1–4, 6, 8–13, 16, 25, 26, and 40–44 are pending. Applicants thank the Examiner for finding the subject matter of claim 44 allowable.

### Amendments to the Claims

Claims 1 and 6 have been amended to recite “a *tissue penetrating tip*”. Support for this amendment is found in the Specification, for example, on page 10, lines 15–17 (“First, an entry is initiated by a small skin incision as illustrated in FIG. 5, followed by insertion of the distal portion of the access port 42 as illustrated in FIG. 6. The access port 40 is advanced into the fascial defect until the innermost layer of tissue is penetrated.”).

Claim 44 has been rewritten as an independent claim.

Claims 23, 24, 27, and 28 have been canceled without prejudice as directed to non-elected species.

### Rejections Under 35 U.S.C. § 102

Claims 1, 2, 4, 6, 8–13, 25, 26, and 40–43 stand rejected under 35 U.S.C. § 102(a) as anticipated by IL-158889 (“Popov”). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987)

Independent claims 1 and 6 recite in part “a *tissue penetrating tip*”. The examiner refers to dilating members 49 and 50 of Popov as corresponding to the recited tip. In fact, the dilating members 49 and 50 do not penetrate tissue, but instead, are inserted into an incision formed by an obturator 62, as described in Popov on page 6, last paragraph to page 7, end of paragraph, and in FIGS. 6–9 and 14. In particular, the obturator 62 includes a penetrating means 66 comprising “a sharp element 70 for piercing the body cavity wall”. Popov at page 7, lines 2–5. The arrangement is illustrated in FIG. 10 of Popov, illustrating the trocar 40 with the dilating members 49 and 50. The obturator 62 is received within the trocar 40 with the sharp element 70 extending from the distal end of the trocar 40 past the dilating members 49 and 50. Popov discloses “The use of the obturator 62 with penetrating means 66 as a guide for inserting distal and dilating portions 45, 46

into the primary opening 59, allows to perform forming primary opening 59 and inserting dilating portion 46 therein as a single operation". Popov at page 7, lines 16-19. The sharp element 70 of the penetrating means 66 of the obturator 62 penetrates tissue, forming an opening 59. The dilating members 49 and 50 are inserted into an opening 59, but do not themselves form an opening. Accordingly, the dilating members 49 and 50 do not correspond to the recited "tissue penetrating tip" and independent claims 1 and 6 are not anticipated by Popov for at least this reason. Because claims 2, 4, 6, 8, 9, 12, 13, 25, 26, and 40-43 are dependent on claim 1, and claims 10 and 11 are dependent on claim 6, these claims are also not anticipated by Popov for at least the same reason.

Furthermore, it appears that Popov does not qualify as prior art under 35 U.S.C. § 102(a). The face of Popov indicates a filing date of November 13, 2003. The present application was filed March 22, 2004, about 4 months after Popov was filed. Under Israeli practice, an application does not publish until after completion of examination. See <http://www.wipo.int/pct/guide/en/gdvol2/annexes/il.pdf>, page 5, § IL.06. The Examiner has provided no evidence that Popov published before the filing date of the present application. Similarly, Popov would not qualify as prior art under 35 U.S.C. § 102(e) because it is not a U.S. or PCT application.

### **Rejections Under 35 U.S.C. § 103**

Obviousness is a question of law based on underlying factual inquiries set forth in *Graham v. John Deere*: (1) determining the scope and content of the prior art; (2) ascertaining the differences between the claimed invention and the prior art; and (3) resolving the level of ordinary skill in the pertinent art. Objective evidence of non-obviousness must be also considered. In assessing the differences between the claim and the cited references, every feature of the claim must be disclosed or suggested in the cited references or known to one skilled in the art in making a *prima facie* case of obviousness. A *prima facie* case of obviousness also requires a reasonable expectation of success in the modification or combination of references, which must be found in the cited references or must be known to one skilled in the art. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claim 4 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Popov in view of U.S. Patent No. 5,626,598 (Roth). Claim 4 is dependant on claim 1. The Examiner relies on Popov for disclosing all of the features recited in claim 1 and relies on Roth only for disclosing a sharp, pointed, or bladed tip. As discussed above, Popov does not disclose or suggest every feature disclosed in claim 1. Accordingly, the combination of Popov and Roth does not disclose or suggest every feature recited in claim 4. Accordingly, claim 4 is non-obvious over the cited references for at least this reason.

Claim 16 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Popov. Claim 16 is dependent on claim 1. As discussed above, Popov does not disclose or suggest every feature recited in claim 1. Accordingly, Popov also does not disclose or suggest every feature recited in claim 16, and consequently, claim 16 is non-obvious over Popov for at least this reason.

#### **Rejoinder of Withdrawn Claims**

As all claims are now allowable over the references of record, Applicants request rejoinder of claims 5, 7, 14, 15, 17–22, and 36–39, which are dependent on claim 1.

#### **No Disclaimers or Disavowals**

Although the present paper may include a combination of alterations to the application or claims, or characterizations of claim scope or referenced art, Applicants are not conceding that previously pending claims in this application are not patentable over the cited references. Rather, any alterations and/or characterizations are made to facilitate prosecution of this application. Applicants reserve the right to pursue any previously pending, or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or in any prior prosecution. Accordingly, reviewers of this or any parent, child, or related prosecution history shall not reasonably infer that Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

#### **Conclusion**

Applicants submit that all of the Examiner's rejections have been addressed and overcome, and that all claims are allowable over the art of record. Applicants have submitted amendments and arguments believed to be sufficient to overcome all of the outstanding

Application No. 10/805,864

Responsive to an Office Action dated August 8, 2008

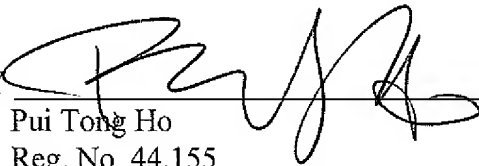
Response filed October 29, 2008

rejections. Consequently, Applicants have not advanced every argument for the allowability of the claims over the references of record. As such, Applicants do not acquiesce to any of the Examiner's statements or characterizations not specifically traversed. Should the Examiner believe that any outstanding issues are resolvable in an Examiner's Amendment, the Examiner is invited to contact the undersigned.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 01-2215.

Sincerely

APPLIED MEDICAL RESOURCES

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